

**REMARKS**

Review and reconsideration of the Office Action dated August 25, 2004, is respectfully requested in view of the above amendments and the following remarks.

Claims 8-19 are under examination.

Claim 8 has been amended to incorporate claim 13.

As of consequence of the amendment to claim 8, the rejection of claims 8-10, 15 and 17-19 under 35 U.S.C. 102(b) has been addressed.

As of consequence of the amendment to claim 8, the rejection of claims 8-12 and 15-19 under 35 U.S.C. § 103(a) has been addressed.

Claims 11 and 12 have been amended to overcome the rejection under 35 U.S.C. 112, second paragraph. In addition, as of consequence of the amendment to claim 8, the rejection of claim 14 under 35 U.S.C. 112, second paragraph, has been addressed.

**Office Action**

Turning to the Office Action, the paragraphing of the Examiner is adopted.

Claim Rejection - 35 U.S.C. § 102(b)

The Examiner has rejected claims 1(sic, 8)-10, 15 and 17-19 under 35 U.S.C. 102(b) as allegedly anticipated by US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780. We assume that the Examiner means Claim 8 rather than Claim 1, which was previously cancelled.

The Examiner contends that US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780 disclose a mixture in which the claimed trans-isomer is inherently present. Moreover, according to the Examiner, the process steps of the prior art anticipate the claimed process steps regardless of the manner the product is characterized in the prior art.

In response, Applicants have amended claim 8, by adding the recitation "in the presence of a base and".

Applicants respectfully submit that neither US Patent 4,252,986 or US Patent 4,623,750 or SU Patent 1,082,780 teaches the method of the present invention in the presence of a base.

Therefore, US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780 do not anticipate claim 8, as amended, and claims 9, 10, 15 and 17-19 under 35 U.S.C. 102(b). Accordingly, withdrawal of the rejection under 35 U.S.C. 102(b) is respectfully requested.

Claim Rejection - 35 U.S.C. § 103(a)

The Examiner has rejected claims 1(sic, 8)-12 and 15-19 under 35 U.S.C. § 103(a) as allegedly unpatentable over US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780.

The Examiner alleges that the claimed reactants are quite analogous to the reactants exemplified in the reference. According to the Examiner, the use of a new starting material in an otherwise old process is considered obvious. Furthermore, the Examiner indicates that it is well within the skill of the artisan to operate within the parameters suggested by the disclosure of the reference and carry out the prior art process with the expectation that one will obtain the results taught in the reference.

In response, Applicants respectfully submit that claim 8, as amended, is not obvious over US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780 since none of these references teaches the method of the present invention in the presence of a base. Accordingly, claims 8-12 and 15-19 are not unpatentable under 35 U.S.C. § 103(a) over US Patent 4,252,986, US Patent 4,623,750 and SU Patent 1,082,780.

Therefore, Applicants respectfully request the withdrawal of the rejection to Claim 8-12 and 15-19 under 35 U.S.C. § 103(a).

**Claim Rejection - 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 11, 12 and 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out the claimed invention.

The Examiner alleges that the recitation "said Raney nickel" in claims 11, 12 and the recitation "said base" in claim 14 lack of antecedent basis in the parent claim.

In response, Applicants have amended claims 11 and 12 to refer to claim 9, which contain the proper antecedent basis for the term "Raney nickel" in claims 11 and 12.

With respect to claim 14, Applicants respectfully submit the amendment of claim 8 introduces proper antecedent basis for the recitation "said base".

Therefore, claims 11, 12 and 14 are not longer indefinite under 35 U.S.C. 112, second paragraph. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

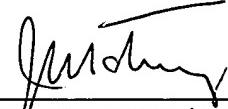
**Allowable Subject Matter**

The Examiner has indicated that claim 13 would be allowable if rewritten as an independent claim with all the limitations of the base claim and any intervening claims.

Applicants respectfully submit that claim 13 has been cancelled and incorporated into claim 8, which has been amended accordingly.

Applicants believe that all the claims are now allowable. Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,

  
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Date: January 25, 2005

**CERTIFICATION OF MAILING AND AUTHORIZATION TO CHARGE**

I hereby certify that a copy of the foregoing AMENDMENT A for U.S. Application No.: 10/666,777 filed September 18, 2003, was deposited in first class U.S. mail, postage prepaid, addressed: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **January 25, 2005**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

  
John J. Martinez, M.D., J.D.